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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,575	12/12/2003	Yoshio Ichikawa	Q78738	8619

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EXAMINER

MIGGINS, MICHAEL C

ART UNIT PAPER NUMBER

1772

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,575

Applicant(s)

ICHIKAWA, YOSHIO

Examiner

Michael C. Miggins

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

REJECTIONS WITHDRAWN

1. There are no rejections withdrawn.

REJECTIONS REPEATED

2. The 35 USC 103(a) rejection of claims 1-20 as being unpatentable over Wright in view of Ichikawa is repeated for the reasons of record in the non-final rejection of 4/22/2004, pages 2-5, paragraphs 1-2. Applicant has now amended claim 1 by adding the limitation "further comprising (C) at least one synthetic resin binder". Ichikawa teaches at least one synthetic resin binder (column 3, line 25 through column 4, line 51) since the organoalkoxysilanes are hydrolyzed to form polymers followed by curing and thus the organoalkoxysilanes serve as binders (column 3, line 64 through column 4, line 2).

NEW REJECTIONS

3. There are no new rejections.

ANSWERS TO APPLICANT'S ARGUMENTS

4. Applicant's arguments with regard to claims 1-20 filed 7/22/2004 have been carefully considered but are deemed unpersuasive. Applicant's summary of the rejections currently of record on page 7 of the amendment filed 7/22/2004 is acknowledged.

Applicant has argued that Wright is not directed to a coating at all like that of the presently claimed invention. However, Wright does disclose a metal containing catalyst for use in fuel tanks which provides improved combustion efficiency and reduce the products of incomplete combustion from the exhaust (page 1). The catalyst has been found to reduce gelling (page 2). Furthermore, Ichickawa was cited as a secondary reference for its teaching of a metal containing catalyst used to subdivide molecules of gasoline and oil thereby promoting complete combustion (improved combustion efficiency) (column 1, lines 6-22, column 10, lines 55-68) in a fuel tank (column 17, lines 35-42).

Applicant has argued that Ichikawa is directed to a method for reforming hydrocarbons, and is not directed to a fuel tank having a specific coating composition of the inner face thereof. However, Ichikawa is directed to a metal containing catalyst for promoting complete combustion (improved combustion efficiency) (column 1, lines 6-22, column 10, lines 55-68) in a fuel tank (column 17, lines 35-42). Wright teaches a metal containing catalyst on an inner wall of a fuel tank for providing improved combustion efficiency (page 1, lines 1-7 and page 1, lines 14-18). It is the combined teachings of Wright and Ichikawa which disclose applicant's invention as claimed.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant has argued that the examiner has used impermissible hindsight. However, both references are drawn to metal containing catalysts with improved combustion efficiency for use in fuel tanks and the catalyst of Ichikawa provides improved fine atomization. Because both references are drawn to metal containing catalysts with improved combustion efficiency for use in fuel tanks, impermissible hindsight has not been used.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant has argued that neither reference discloses or suggests the synthetic resin binder component now recited in claim 1. However, Ichikawa teaches at least one synthetic resin binder (column 3, line 25 through column 4, line 51) since the organoalkoxysilanes are hydrolyzed to form polymers followed by curing and thus the organoalkoxysilanes serve as binders (column 3, line 64 through column 4, line 2).

Applicant has argued that the coating film can be dried and cured at a low temperature of 80 to 200 degrees C and the substrate of Ichikawa is obtained by baking at high temperatures of 1,100 to 1,600 degrees C (column 13, lines 33-37) and thus the

inventions are seen to be quite different. However, it is only the substrate which is baked at the temperatures and in fact the coating of Ichikawa is cured at 280 degrees C (column 13, lines 38-40). Therefore, the curing temperatures of the claimed coating and that of Ichikawa are similar.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (571) 272-1494. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael C. Miggins
Examiner
Art Unit 1772



MCM
September 27, 2004